Applicant(s)	McCallister	**RESPONSE UNDER 37 C.F.R. § 1.173**
Serial No.	10/718,505	
Filing Date	11/20/2003	
Confirmation No.	1245	
Examiner Name	Corrielus, Jean B.	
Group Art Unit	2611	
Attorney Docket No.	125.136USR1	
Title: CONSTRAINED-ENVELOPE TRANSMITTER AND METHOD THEREFOR		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS

The Office Action mailed on July 18, 2007 has been reviewed, along with the art cited. Claims 2-11 and 13-23 are pending in this application. This paper is accompanied by a Petition, as well as the appropriate fee, to obtain a 3-month extension of the period for responding to the Office action, thereby moving the deadline for response from October 18, 2007 to January 18, 2008. This response does not include any amendments to the claims of this reissue application.

Rejections Under 35 U.S.C. § 112

Claims 21-23 were rejected under 35 USC § 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner asserts that the specification fails to support the term "fixed delay" as used in claim 21. Applicant respectfully traverses this assertion.

The present application describes the delay at least at Col. 11, lines 46-54. In this passage, the Applicant explains the function of the delay as follows:

> Modulated signal 74 is also passed to the input of a delay element 138. Delay element 138 produces delayed modulated signal 140, which is effectively modulated signal 74 delayed sufficiently to compensate for the propagation and other delays encountered in off-time constrained-envelope generator 106, and particularly in off-time pulse-spreading filter

> 134. In other words, delayed modulated signal 140 is modulated signal 74 delayed into synchronism with off-time constrained-bandwidth error signal stream 108.

Applicant respectfully asserts that one of ordinary skill in the art would understand that the delay in the signal path is constant and thus the delay is fixed. Therefore, the application meets the written description requirement to support the "fixed delay" limitation of the claim. Withdrawal of the rejection is respectfully requested.

Inventor Submissions and the May Reference

The Applicant respectfully asserts that the Examiner has improperly given weight to the submissions of the inventor, Mr. McCallister, concerning the teachings of the May reference (discussed further below). Mr. McCallister stated in his submissions in July and August 2005 that he has "no interest in the application." It appears that he made these statements to establish that he is unbiased and impartial in his opinion concerning the teachings of May. From the record, it also appears that Mr. McCallister has been successful in convincing the Examiner that he is an impartial witness as the Examiner accepted his submission over Applicant's expert stating, without explanation, that Mr. McCallister "is the better expert in the field of his own invention." Applicant respectfully submits that Mr. McCallister is not the better expert.

McCallister is not Impartial

In June 2007, the Applicant submitted evidence that calls into question the impartiality of Mr. McCallister as an expert. According to this evidence, Mr. McCallister attempted to obtain an exclusive license to the patent that is the basis for this reissue application for his employer. See Declaration of Paul Bernkopf, at ¶¶ 3-5. Mr. McCallister did not receive any license to the patent for his employer. Id. at ¶¶ 6-7. Because Mr. McCallister did not obtain any license to the patent for his employer, his employer may be required to pay royalties to the owner of the present application. This makes his interest *adverse* to the issuance of this reissue application as explained on p. 14

of the Response filed on June 11, 2007 in this application. Mr. McCallister's employer would benefit from the reissue application being denied or issuing with narrower claims.

Mr. McCallister's actions continue to demonstrate that he has an adverse interest in the current application. For example, this application is related to U.S. Application Serial No. 10/718,507. The Examiner indicated that some of the claims in that application were allowable. In response to this indication of allowability of some of the claims, Mr. McCallister generated further submissions in September and November 2007 arguing that most of these claims are not allowable. This clearly demonstrates that Mr. McCallister is attempting to protect the interests of his employer to avoid any liability for practicing the invention covered in these two reissue applications.

In the **Response to Arguments** section of the current office action, the Examiner did not address the issue of bias raised by the Bernkopf Declaration. The Bernkopf Declaration directly addresses the credibility of the inventor. Despite the evidence presented by the Applicant, the Examiner continued to point to the inventor's submission as support for the rejection but did not even acknowledge the Bernkopf declaration. If the Examiner has reasons to not accept the Bernkopf Declaration, the Examiner should put those reasons on the record so that the issue can be properly resolved on review by the Board of Appeals.

McCallister's Submissions are Burdened with Hindsight

In addition to bias, Mr. McCallister cannot be considered a better expert with respect to his invention because of the likelihood that hindsight will taint his view of the prior art. Mr. McCallister is an inventor. He is not one of ordinary skill in the art nor has he demonstrated that he is capable of opining on the knowledge of one of ordinary skill in the art. In addition, Mr. McCallister was able to solve the problems addressed by his invention and is thus intimately familiar with the need for delay from his own work *as an inventor*. Given that familiarity with the issues, it would not be unreasonable to expect that he would view the prior art, such as May, through the lens of his own invention. In this light, it is to be expected that he would draw the conclusion that May requires the

delay issue to be addressed; not because one of ordinary skill in the art would understand the issue that way, but, because an inventor would. His intimacy with the issue makes him a bad expert as it leads to hindsight reconstruction of his invention from the prior art.

Applicant respectfully requests that the Examiner re-evaluate the probative value of Mr. McCallister's submissions in light of his true interest in the present application and the likelihood of hindsight creeping into his analysis. Applicant submits that, when viewed in this light, the Examiner should not accept the allegations regarding the teachings of May in these submissions.

Rejections Under 35 U.S.C. § 102

Claims 2-5, 8-11, 13-16, 18, and 20-23 were rejected under 35 USC § 102(a) as being anticipated by May. Applicant respectfully traverses this rejection.

Independent claims 2, 14, and 18 each include a "delay" limitation. For example, claim 2 specifies:

> a delay element coupled between said modulated-signal generator and said combining circuit to delay said first modulated signal into synchronism with said constrained bandwidth error signal.

The Examiner has adopted the position asserted by the inventor that the delay limitation is inherent in May. For example, in commenting on claim 2, the Examiner stated:

> In addition, as noted in the inventor submission filed on 7/5/05, a delay coupled between said modulated signal generator and said combining circuit to delay said first modulated signal into synchronism with said constrained bandwidth error signal, is inherent.

In the cited declaration, the inventor states:

> The May paper teaches that you must identify the instant in time in which a signal peak occurs, and then subtract a scaled version of a fixed pulse-shape from the input signal, where the peaks of the pulse- shape and the signal have been time-aligned. Since the pulse-shape extends in both directions in time from the point at which its peak occurs, the teaching clearly requires that the input signal is delayed by at least half of the pulse-shape duration. In view of the foregoing, it is clear that May's

> approach inherently uses a delay; in my opinion it cannot be done any other way.

In discussing this issue, the inventor did not say that *one of ordinary skill in the art* would read May this way. Rather, he gave his opinion, as an expert/inventor, that he would read it this way. It is understandable that Mr. McCallister would read May to require the delay element because, as an inventor, he discovered and understood the need for the delay in his own work. Applicant respectfully submits that Mr. McCallister's submission does not shed any light on how *one of ordinary skill in the art* would read May due to his expert knowledge and his inventive insights in his own work. Further, as discussed above, Mr. McCallister is tainted by his own interest in having the claims found unpatentable or being forced to be narrowed.

Applicant incorporates the arguments presented at pp. 14-15 of the prior response to establish that one of ordinary skill in the art would not understand May does not inherently disclose a delay element as claimed. In the response to arguments section of the Office Action, the Examiner states:

> In addition the affidavit [of Applicant's expert] alleged that feeding May's modulated signal through a fixed delay will not correctly aligned [sic] the amplitude peaks. Such argument suggests at least that **a non-fixed delay** is used in the May's reference therefore implementing a fixed delay (inherently taught by the May reference) in the May's system could be easily done without undue experimentation.

Applicant respectfully traverses this assertion. In making this assertion, the Examiner has taken liberty with the Applicant's words. Nothing in Applicant's argument suggests that one of ordinary skill in the art would understand that a non-fixed delay is used in May. Further, the Examiner's conclusion that implementing a fixed delay would be easily done without undue experimentation is equally unfounded.

Based on the foregoing arguments, Applicant respectfully requests that the Examiner withdraw the rejection and allow claims 2-5, 8-11, 13-16, 18, and 20-23.

Rejections Under 35 U.S.C. § 103

Claims 6, 7, 17, and 19 were rejected under 35 USC § 103(a) as being unpatentable over May in view of U.S. Patent No. 6,266,320 (Hedberg). Applicant respectfully traverses this rejection.

Claim 19 depends from claim 18 and is allowable at least for the reasons identified above with respect to claim 18.

Claims 6, 7, and 17 each include a limitation related to a "linear amplifier" or "linearly amplifying." Applicant respectfully submits that May does not teach or suggest the use of a linear amplifier or linearly amplifying as called for in the claims. As support for this position, Applicant relies on the Declaration of J. Neil Birch, dated June 5, 2007 at ¶¶ 9-12. In light of the arguments presented above with respect to the credibility of Mr. McCallister's submissions, Applicant requests the Examiner to reconsider the testimony of Dr. Birch with respect to these limitations. Based on this testimony, Applicant asserts that claims 6, 7, and 17 are also allowable. Withdrawal of the rejection is respectfully requested.

CONCLUSION

Applicant respectfully submits that claims 2-11 and 13-23 are in condition for allowance and notification to that effect is earnestly requested. If necessary, please charge any additional fees or credit overpayments to Deposit Account No. 502432.

If the Examiner has any questions or concerns regarding this application, please contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: January 18, 2007

/David N. Fogg/
David N. Fogg
Reg. No. 35138

Attorneys for Applicant
Fogg & Powers LLC
P.O. Box 581339
Minneapolis, MN 55458-1339
T – (612) 332-4720
F – (612) 332-4731